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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/725,531

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Eugene M. Lee

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EXAMINER

CORRIELUS, JEAN M

ART UNIT

PAPER NUMBER

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/725,531	<b>Applicant(s)</b> LEE, EUGENE M.	
	<b>Examiner</b> Jean M. Corrielus	<b>Art Unit</b> 2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10/29/08.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15, 16, 18-25, 27-33, 35-41 and 43-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15, 16, 18-25, 27-33, 35-41 and 43-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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### **DETAILED ACTION**

1. This office action is in response to the Request for Continued Examination filed on October 29, 2008, in which claims 1-13, 15-16, 18-25, 27-33, 35-41 and 43-45 are presented for further examination.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 29, 2008 has been entered.

#### ***Response to Arguments***

3. Applicant's arguments with respect to claims -13, 15-16, 18-25, 27-33, 35-41 and 43-45 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-13, 15-16, 18-25, 27-29, 38-41 and 43-45 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-13, 15-16, 18-25 and 27-29 define a method of managing attributes in association with a plurality of

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electronic documents. However, the method as claimed does not qualify as a 101 statutory process because the method as claimed does not positively recite the other statutory class (the thing or product) to which it is tied by identified the apparatus that accomplish the method steps. (see *n re Bilski*)

Claims 38-41 and 43-45 define a system for managing attributes in association with a plurality of electronic documents

. Such a system is not embedded in processor and memory to perform the steps as claimed. Applicant should duly note that the use of the word system does not inherently mean that the claim is directed to a machine. Only if at least one of the claimed elements of the system is a physical part of a device can the system as claimed constitute part of a device or a combination of devices to be a machine within the meaning of 101. The memory is not an element of the claimed system, but instead is, at best, for use with the claimed system. After further review the specification. It is evident that system would suggest to one of ordinary skill that all may be reasonable implement as software routines. The claimed invention is addressed to "a system" that can be interpreted as referring to lines of programming within the computer system, rather than referring to the system as a physical object. Therefore, the claims are rejected as a system of software per se, for failing to fall within a statutory category of invention

"Software per se" is non-statutory under 35 USC 101 because it is merely a set of instructions without any defined tangible output or tangible result being produced. The requirement for tangible result under 35 USC 101 is defined in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 47USPQ2d 1596 (Fed. Cir. 1998)

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***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-13, 15, 16 and 18-25, 27-33, 35-41 and 43-45 rejected under 35 U.S.C. 103(a) as being unpatentable over Grainger US Patent Publication no. 200/011636 and in view of Morgenstern US Patent 5,970,490.

As claim 1, Grainer discloses the use of managing documents related to patent applications (Abstract; [002]). Grainer discloses the claimed “a plurality of attributes in association with a plurality of electronic documents” (a plurality of electronic document related to patent application, wherein the electronic documents has a plurality of attribute associated therein, [0016], lines 1-5), and “interacting with a user to select a plurality of attribute types implemented by a computer system, where an attribute type can have a plurality of attributes, the attributes” (document types, [0015]); “a document can be assigned a plurality of attribute, types at a same and/or different level in the hierarchy, a document can be assigned a plurality of attributes for one attribute type” (navigating through the electronic document, using multiple groupings or multiple level of grouping, [0109]); “the documents are stored in a first data storage” (central data repository of all information regarding patent process, item 100), “the attributes are stored in a second data storage” (database, item 106 organized into document entities), and “the first data storage and the second data storage are logical separate and different” (set of attribute listed in an appropriate table in database 106; whereas, system 100 for central data repository of all

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information regarding patent process). Grainger discloses the claimed a sequential event ([0004], lines 1-2); “providing a group of a plurality of documents including at least one document” (a plurality of electronic document related to patent application, wherein the electronic documents has a plurality of attribute associated therein, [0016], lines 1-5). It is inherent that a plurality of documents would include at least on document; “selecting a plurality of attributes to be associated with the at least one document” (according to the claimed the attribute is not yet associated with the document, in that Grainger discloses a plurality of attributes associated with a document, [0016], lines 1-5); “for each selected attributes, automatically tagging in the first data storage, the documents in the group including the at least one document, with each selected attribute and with all attributes of all ancestors in the hierarchy of each selected attribute, and storing in the second data storage respective references in association with each selected attribute and the ancestor attributes, for later retrieval of individual documents in the first data storage” (automatically associated the electronic documents with the plurality of attributes, [0016], lines 1-5); “wherein a document is a data record including a plurality of fields” (document includes plurality of fields, {0071}); “wherein the attribute and attribute type can be different from the fields in the document and contents of the fields” (populating the document fields from the attribute, [0071]. Grainer discloses Web page (item 40b), which includes html links to Save, Cancel and proceed to the Next step (i.e., instruct server 102 to display the next Web page to the client system), wherein each of these links is labeled with a reference number identical to the reference number used in Web page. It should be noted that selecting the Next function from Web page takes the client system to a different Web page than selecting the Next function from Web page. So, the reference numbers are used for similar

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functions throughout each of Web pages, see FIGS. 3A-3L). Moreover, as shown in FIG. 3B, the Web page (item 40b) includes a link that takes the inventors back to the previously shown Web page so that the inventor can review and/or edit information previously entered. Such manipulation would allow an inventor to easily skip a certain field presented on one Web page and return to that field at a later time to complete the invention disclosure. However, Grainger does not explicitly disclose the claimed “the attribute types are ordered in a tree-structure hierarchy”. On the other hand, Morgenstern focuses on hierarchical tree-structures as a dominant structuring mechanism. Of course certain semantic attributes, such as type of attribute has meaning under just one interpretation attribute, which it uses to determine how other attributes and constructs of the specification should be interpreted, wherein the tree structure is a projection of the structure of the original tree, see col.9, lines 60-67; col.12, lines 56-64 and col.43, lines 7-20). This implication discloses the claimed “the attribute types are ordered in a tree-structure hierarchy, wherein the attributes can be any of the plurality of attributes”. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Grainger’s system by incorporating the use of having an attribute type ordered as a tree structure, in the same conventional manner as disclosed by Morgenstern. One having ordinary skill in the art would have found it motivated to create an annotated logical structure diagram which serves as a graph representing relationship of source data in a context-independent uniform manner in order to eliminate tedious and costly specialized translators by utilizing declarative specification language to represent the source and target data representations.

As to claim 2, Grainger discloses the claimed “wherein providing the group of documents included in the group of document responsive to a user” ([0061]).

As to claim 3, Grainger discloses the claimed “organizing the group of documents, wherein the documents are sorted for visual presentation by at least one field therein, wherein the at least one field is different from the attribute and attribute type associated therewith” ([0105]).

As to claim 4, Grainger discloses “assigning at least one of documents to at least one other group” ([0109]

As to claim 5, Grainger discloses, “wherein the group of documents omits a lapsed document” (automatically deleting the lapsed in favor of the actual due date or a later reminder, [0088]).

As to claim 6, Grainger discloses, “wherein the document is image file format ([0064]).

As to claim 7, Grainger discloses “searching the second data storage for document based on criteria including the attribute and attribute type, and using the respective references in the second data storage to locate the documents in the first data storage” ([0098]).

As to claim 8, Grainger discloses “retrieving the located documents from the first storage based on the respective references” ([0098]).



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As to claim 9, Grainger discloses “displaying information characterizing the documents” ([0098]).

As to claim 10, Grainger discloses “limiting access to the at least one attribute” (the priority licensees will be able to access appropriate data describing the IP assets (e.g., title, abstract, claims, inventor list) through Web pages that have restricted access rights, see [0048]).

As claim 11, Grainger discloses “a reference to a URL” ([0098})).

As to claim 12, Grainger discloses a patent portfolio.

As to claim 13, Grainger discloses a preliminarily determining a plurality of attributes” (type attribute associated with document Entities, [0134], and one or more attributes [0016]).

As to claim 15, Grainger discloses “wherein the attribute are selected from a plurality of attribute types” (type attribute associated with document Entities, [0134], and one or more attributes [0016]).

As to claim 16, discloses the claimed “current owner” (inventor and other entities, [0004]).

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As to claim 18, Grainger discloses the claimed “attributes and the plurality of attribute types” (type attribute associated with document Entities, [0134], and one or more attributes [0016]).

As to claim 19, Grainger discloses the claimed “utilizing the attribute as a search” ([0098]).

As to claim 20, Grainger discloses “an attribute type” (type attribute associated with document Entities, [0134]).

As to claim 21, Grainger discloses “serial number of the document” (a patent application number (serial number), [0057]).

As to claims 22-25, 27-29, the limitations of claims 22-25 and 27-29 have been noted in the rejection of claims 1-13, 15, 16 and 18-21 above. In addition, Grainger discloses the claimed “wherein the at least one document and the at least one other document are representative of a patent document” electronic document is related to patent applications, see [0016]).

Claims 30-33 and 35-37 are computer program product comprising instructions to execute the method of claims 1-13, 15, 16 and 18-21. They are, therefore, rejected under the same rational.

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Claims 38-41 and 43-45 are system to execute the method of claims 1-13, 15, 16 and 18-21 above. They are, therefore, rejected under the same rationale.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean M. Corrielus whose telephone number is (571) 272-4032. The examiner can normally be reached on 10 hours shift.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jean M Corrielus/  
Primary Examiner, Art Unit 2162

December 24, 2008